

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 09/589,288

Confirmation No. 1519

Applicant: Yu et al.

Filed: June 8, 2000

TC/AU: 1647

Examiner: Bridget E. Bunner

Docket No.: 702041 (Client Reference No. PF343P3C5)

Customer No.: 73326

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT

PURSUANT TO 37 C.F.R. § 1.705(b)

Sir:

Pursuant to 37 C.F.R. § 1.705(b), Applicants request reconsideration of the Determination of Patent Term Adjustment indicated in the Notice of Allowance mailed on July 25, 2011. Applicants submit herewith the appropriate fee pursuant to 37 C.F.R. § 1.18(e).

The Notice of Allowance mailed on July 25, 2011 indicates that the patent term adjustment to date is 1991 days. Specifically, the patent term adjustment history in the USPTO's patent application information retrieval (PAIR) database indicates that the total USPTO A delay to date is 1677 days, that the total USPTO C delay to date is 763 days, and that the total Applicant delay to date is 449 days. A copy of the patent term adjustment history is attached hereto for the Office's consideration.

Applicants agree with the USPTO's calculation that the total USPTO delay to date under 37 C.F.R. §§ 1.702(c)-(e) and 1.703(c)-(e) (referred to by the Office as "C Delay") is 763 days. Applicants also agree with the USPTO's calculation that the total Applicant delay to date under 37 C.F.R. § 1.704 is 449 days.

Applicants note that the patent term adjustment under 37 C.F.R. §§ 1.702(b) and 1.703(b) (referred to by the Office as “B Delay”) has not yet been calculated. Applicants also note that the overlapping days between the “A and B” delays and between the “A and C” delays have not yet been calculated.

Applicants respectfully request reconsideration of the USPTO’s calculation of the total USPTO delay to date under 37 C.F.R. §§ 1.702(a) and 1.703(a) (referred to by the Office as “A Delay”), for the reasons set forth below.

This request is being timely made, as it is being submitted after the Notice of Allowance was mailed and not later than the payment of the issue fee, as required by 37 C.F.R. § 1.705(b).

The requirements of 37 C.F.R. § 1.705(b)(2) are satisfied by the following Statement of Facts:

1. The present application was filed on June 8, 2000, and is eligible for patent term adjustment under 35 U.S.C. § 154.
2. The present application is subject to a terminal disclaimer based on the expiration date of the full statutory term of U.S. Patent 7,879,328. The face of U.S. Patent 7,879,328 indicates that it is entitled to 762 days of patent term adjustment.
3. The USPTO’s patent term adjustment calculation indicates that the total Applicant delay to date under 37 C.F.R. § 1.704 is 449 days.
4. The USPTO’s patent term adjustment calculation indicates an Applicant delay of 92 days from May 21, 2001, the day after the date that is three months after the date of mailing of a Restriction Requirement, through August 20, 2001, on which date a Reply to Restriction Requirement was filed by Applicants.
5. The USPTO’s patent term adjustment calculation indicates an Applicant delay of 86 days from February 7, 2002, the day after the date that is three months after the date of mailing of an Office Action, through May 3, 2002, on which date a Reply to Office Action was filed by Applicants.

6. The USPTO's patent term adjustment calculation indicates an Applicant delay of 91 days from November 14, 2002, the day after the date that is three months after the date of mailing of an Office Action, through February 12, 2003, on which date a Notice of Appeal was filed by Applicants.

7. The USPTO's patent term adjustment calculation indicates an Applicant delay of 90 days from September 4, 2003, the day after the date that is three months after the date of mailing of an Office Action, through December 2, 2003, on which date a Reply to Office Action was filed by Applicants.

8. The USPTO's patent term adjustment calculation indicates an Applicant delay of 90 days from September 4, 2004, the day after the date that is three months after the date of mailing of an Office Action, through December 2, 2004, on which date a Request for Continued Examination was filed by Applicants.

9. Other than the circumstances described above, there have been no circumstances that could reasonably be construed as a failure to engage in reasonable efforts to conclude processing or examination of this application.

10. The USPTO's patent term adjustment calculation indicates that the total USPTO delay to date under 37 C.F.R. §§ 1.702(a) and 1.703(a) is 1677 days.

11. A Notice of Allowance was mailed in the present application on July 27, 2009.

12. An issue fee transmittal, together with the payment of the appropriate issue fee, was filed in the present application on October 22, 2009, which is within three months of the July 27, 2009 mailing date of the Notice of Allowance.

13. An Issue Notification was mailed in the present application on September 15, 2010, indicating a projected patent issue date of October 5, 2010.

14. Pursuant to 37 C.F.R. § 1.703(a)(6), the period of patent term adjustment due to examination delay includes the number of days, if any, in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued.

15. A petition to withdraw the present application from issue, together with a Request for Continued Examination, was filed on September 23, 2010. As such, Applicants ended the period of adjustment under 37 C.F.R. § 1.703(a)(6) on September 23, 2010, prior to issuance of the patent.

16. The issue fee transmittal, together with the payment of the appropriate issue fee, was filed in the present application on October 22, 2009, thereby satisfying the requirements under 37 C.F.R. § 1.703(a)(6) on October 22, 2009.

17. Pursuant to 37 C.F.R. § 1.703(a)(6), the term of the present application should be adjusted for the period beginning on February 23, 2010 (the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied) and ending on September 23, 2010 (the date Applicants filed a petition to withdraw the patent from issue, thereby ending the period of adjustment under 37 C.F.R. § 1.703(a)(6)), which is a period of 213 days.

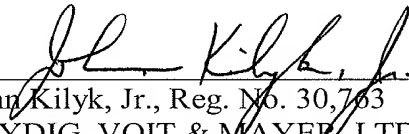
In view of the facts set forth above, Applicants respectfully request that the USPTO's calculation of the total USPTO delay to date under 37 C.F.R. §§ 1.702(a) and 1.703(a) be reconsidered and corrected. Specifically, the USPTO failed to issue a patent on the present application within four months from the date the issue fee was paid and all outstanding requirements were satisfied (i.e., within four months of October 22, 2009). As such, the prosecution of the present application was delayed by the USPTO for a period of 213 days from February 23, 2010 through September 23, 2010 (see 37 C.F.R. § 1.703(a)(6)), i.e., from the day after the date that is four months after the date the issue fee was paid until the filing by Applicants of a petition to withdraw the patent from issue. The addition of this USPTO delay to the USPTO's patent term adjustment calculation results in a total USPTO delay to date under 37 C.F.R. §§ 1.702(a) and 1.703(a) of 1890 days.

Payment of application for patent term adjustment fee (37 C.F.R. § 1.18(e))

- ☒ Please charge Deposit Account No. 12-1216 in the amount of \$200.00.
- ☐ A check in the amount of \$ is enclosed.
- ☒ Charge Account No. 12-1216 for any additional fee required.

The Commissioner is further authorized to charge any extension of time fees pursuant to 37 C.F.R. 1.17(a)-(d) associated with this communication and to credit any excess payment to Deposit Account No. 12-1216.

Respectfully submitted,



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